

REMARKS

Claims 1-19 and 21-44 are in this application. Claims 18, 21, 23, 29 38 and 44 have been amended. The subject matter of claim 20 has been incorporated into claim 18 and claim 20 has been cancelled. Claim 38 has been amended to clarify that in the process of claim 38 the persulphate is used in water. Support for this is found, *inter alia*, in examples 1, 2, and 4.

The Examiner has rejected claims 18-44 under 35 USC 112, first paragraph. Applicants respectfully traverse this rejection.

Claim 18 has been amended to delete the phrase "in a molar ratio of hydrophobic to hydrophilic groups of 1.0:0.1."

Applicants preserve all rights to reintroduce this subject matter into one or more claims of this application or to include this subject matter in one or more continuation or divisional applications.

Therefore, it is respectfully requested that this rejection be withdrawn.

The Examiner has rejected claims 18, 19, 24-37 and 43 as being obvious over Mertens et al. (US Patent 5,408,019).

Applicants respectfully traverse this rejection.

Mertens et al is directed to preparation of water absorbent polymers and not to an absorbent useful for gelling organic liquids. The Examiner's attention is drawn to:

a) Col. 1, lines 8-10; "The present invention relates to a cross-linked polymer which absorbs aqueous liquids."

b) Col. 1, line 16; "These water-absorbing polymers find a great variety of uses."

c) Col. 1, lines 20-22; "These polymers are mainly used to absorb fluids which are produced or present within the body, in particular urine, and are therefore employed in diapers and adult incontinence , cable sheathings, cleaning clothes, or they are used in soil conditioning."

d) Col. 2, line 40-44; "The known water -absorbent polymers do not provide the required property combination of high retention and high absorption under load, low content of residual monomers and small amounts of extractable portions."

Nothing in this reference discloses or suggests swelling the polymer in an alcohol to obtain the polymeric absorbent and this is noted by the Examiner on page 4 of the Official Action.

The Examiner's reference to pages 2 and 3 of applicants' specification does not overcome the lack of disclosure or suggestion in Mertens of swelling the polymer in an alcohol. In addition, as stated above, Mertens is directed to a polymer for absorbing aqueous liquids. As the claimed invention is directed to a polymer useful for absorbing organic compounds, one skilled in the art would not look to Mertens which describes preparation of a polymer for a purpose different from the purpose claimed in this application.

In addition, Merten teaches neutralization to the extent of at least 30% mol-% of the unsaturated, polymerizable monomers with acid groups. Merten also teaches that polymerization is carried out using a redox system consisting of formamidine sulfinic acid and one or several organic peroxides. One skilled in the art would consider this reference for preparing a polymer for absorbing aqueous liquids or water and not for gelling organic acids.

Claims 18, 19, 24-37 and 43 are not obvious over Merten and it is respectfully requested that the rejection be withdrawn.

The Examiner has rejected claims 18-44 as being obvious over Welsey et al. (US Patent 5,641,890). Applicants respectfully traverse this rejection.

Welsey et al. discloses reacting a commercial polymer with an alcohol and the teaching of swelling the polymer in alcohol as taught by the examples of the reference, does not relate to the present invention. This is so because the polymer described in Wesley et al. is already prepared and then reacted with a rheological additive, which increases the viscosity of the gelled solvent. The Examiner's attention is drawn, for example, to column 4, lines 6-8 ("To the solution of the amine neutralized crosslinked anionic polymer is added with mixing an auxiliary rheological additive.") As the Examiner stated on page 5 of the Official Action of May 29, 2001, "the polymers, such as CARBOPOLS of Wesley are commercial products."

Claim 18 has been amended to define that the mixing of the one or more monomers, cross linking agent and free radical initiator occurs *in situ* and the polymerization takes place in the presence of a transition metal source. Support for this amendment is found on page 3, lines 13-15.

According to MPEP 2141 when applying 35 USC 103, the following tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole; (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination; (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention and (D) reasonable expectation of success is the standard with which obviousness is determined.

In making this rejection, the Examiner is relying on impermissible hindsight.

A reference must be considered for what it would teach someone skilled in the art at the time the invention was made and not be applied based on "hindsight". See Panduit Corp. V. Dennison Manufacturing Co. 227 USPQ 337, 343 (Fed. Cir. 1985):

It is impermissible to first ascertain factually what applicants did and then view the prior art in such a manner as to select from the random facts of that art only those which may be modified and then utilized to reconstruct appellants' invention from such prior art.


In making its obviousness determination, a court must view the prior art without reading into that art the patent's teachings. Vandenberg v. Dairy Equipment, 224 U.S.P.Q. 195 (Fed. Cir. 1987) citing In re Sponnoble, 160 U.S.P.Q. 237 (CCPA 1969). In Uniroyal . Rudkin-Wiley, 50 U.S.P.Q.2d 1434, 1438 (Fed. Cir. 1988) the CAFC stated:

The obviousness standard, while easy to expound, is sometimes difficult to apply. It requires the decision maker to return to the time the invention was made. The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time...That which may be clear and thus obvious to a court, with the invention fully diagramed and aided by experts in the field, may have been a breakthrough of substantial dimension when first unveiled [citations omitted]. In this case we are convinced that the district court misapplied the obviousness standard. It has impermissibly used hindsight to reconstruct the claimed invention from prior art with the invention before it and aided by Uniroyal's expert, rather than viewing the invention from the position of a person of ordinary skill at the time it was made. When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.

Therefore, the claimed invention is not obvious in view of Wesley et al. and it is respectfully requested that the rejection be withdrawn.

Applicants submit that the present application is in condition for allowance and favorable consideration is respectfully requested.

Respectfully submitted


Janet I. Cord
c/o Ladas & Parry
26 West 61st Street
New York, New York 10023
Reg. No. 33, 778 (212-708-1935)